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EXAMINER

MOORE, M

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 03/31/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/331,959

Applicant(s)  
Dubouis et al.

Examiner  
Margaret Glass Moore

Group Art Unit  
1712



☒ Responsive to communication(s) filed on Sep 28, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1 to 11 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1 to 11 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Claims 1 to 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1:

This claim has two different definitions of mixture B. It is unclear which mixture B is to be included in the composition.

It is unclear what is meant by "(a combination)" after constituent A3, B3 and C2. This appears to be unnecessary and it's presence is confusing.

It is confusing to say that B1 and C1 "has the meaning of constituent A1 of 1" since there is no "1" previously mentioned. The Examiner suggests removing "of 1" in each instance.

The phrase "crosslinking at room temperature... or crosslinking at high temperature..." is confusing since it is not clear if these positive process steps are required in the product. The Examiner suggests replacing "crosslinking" with "crosslinkable".

Claim 2:

? — The phrase "selected from the group formed by... and colorants" is confusing. See M.P.E.P 2173.05(h), drawn to alternative limitations, specifically Markush groups.

The use of parenthesis around "one-component or multi component" confuses this claim since it is unclear if these terms carry the same weight as other claim limitations.

Claim 3:

Reference to "the polyorganosiloxanes - the main constituents" is confusing since it lacks antecedent basis. This refers to the polyorganosiloxanes in the plural, while claim 2 refers to them in the singular. It is unclear if plural polyorganosiloxanes are required or not.

② The phrase "it being possible" is confusing since it is unclear if this constitutes a definite limitation.

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The phrase "haloalkyl radicals... chlorine and/or fluorine atoms" is confusing since it is unclear if these are the only halogens intended by "haloalkyl" and if not it is confusing how this limitation affects other halogens. This applies as well to halocycloalkyl and haloaryl.

Claim 4:

The phrase "chosen from" is indefinite. See M.P.E.P 2173.05(h), drawn to alternative limitations, specifically Markush groups.

The phrase "crosslinking at..." is indefinite since it is unclear if this constitutes a positive process limitation. Also note that reference to "the heat..." lacks antecedent basis.

Claim 5:

The phrase "it being possible" is confusing since it is unclear if this constitutes a definite limitation.

Claim 6:

This claim depends upon claim 2. Reference to RTV compositions lacks antecedent basis.

The phrase "crosslinking at..." is indefinite since it is unclear if this constitutes a positive process limitation. Also note that reference to "the heat..." lacks antecedent basis.

Claim 7:

The phrase "crosslinking at..." is indefinite since it is unclear if this constitutes a positive process limitation. Also note that reference to "the heat..." lacks antecedent basis.

Claim 9:

This claim is apparently intended to be a dependent claim, from the phrase "as defined in" but makes no reference to any other claim. Note that the rest of the claim was deleted, as per applicants' request in the preliminary amendment.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 to 3, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsushita.

Matsushita teaches compositions which contain a combination of  $\text{FeO}/\text{Fe}_2\text{O}_3$  and platinum in a crosslinkable silicone rubber. See for instance the comparative examples 103 and 104. The amounts and ratios of each are within those claimed. These comparative examples meet the composition of claim 1. With regards to claim 11, while patentee is silent as to enhanced arc tracking and arc erosion, this will inherently be met by the composition of Matsushita since it is the same composition as claimed, and it contain the arc tracking and arc erosion enhancing components in what is disclosed by applicants as an effective amount.

5. Claims 4 to 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsushita.

The composition of Matsushita is an improvement over another composition which contains  $\text{FeO}/\text{Fe}_2\text{O}_3$  and platinum. See under Background of the Disclosure, first full paragraph. The Examiner is currently trying to obtain a copy of Japanese Laid Open Patent Publication 50-

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97644, but in the meantime, this rejection will rely on the obviousness of the claims in view of the teachings of Matsushita.

While patentee shows compositions containing platinum and FeO/ Fe<sub>2</sub>O<sub>3</sub> in combination and in the claimed amounts, none meet the specific limitations of claims 4 to 8. The peroxide cured composition of Example 1 does not meet the viscosity requirement of the peroxide containing composition in claim 8, and the hydrosilylation reaction curing composition in Matsushita doesn't contain FeO/ Fe<sub>2</sub>O<sub>3</sub>.

However the siloxanes disclosed in Matsushita embrace the specific siloxane compositions of each of claim 4 to 8. Thus the claims differ from that taught in Matsushita in that the instant compositions contain a non-preferred iron oxide. However, as can be seen from the general teachings and comparative examples in Matsushita, FeO/ Fe<sub>2</sub>O<sub>3</sub> in combination with platinum provides a degree of self extinguishing properties.

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. Disclosed examples and preferred embodiments do not constitute a teaching away from broader disclosures or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). The disclosure of Matsushita reasonably suggests that the combination of FeO/ Fe<sub>2</sub>O<sub>3</sub> and platinum can be used in compositions consistent with those disclosed and thus render obvious the claimed composition. Any difference which may be found in the additives is rendered obvious by the teachings of Matsushita.

“A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.” In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) In this instance, the invention was directed to a an epoxy impregnated fiber-reinforced printed circuit material. The applied prior art reference taught a printed circuit material similar to that of the claims but impregnated with polyester-imide resin instead of epoxy. The reference, however, disclosed that epoxy was known for this use, but that epoxy impregnated circuit boards have “relatively acceptable dimensional stability” and “some degree of flexibility,” but are inferior to circuit boards impregnated with polyester-imide resins. The court upheld the rejection concluding that, while the reference did teach away

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from using epoxy, the "teaching away" was insufficient to overcome the rejection since "Gurley asserted no discovery beyond what was known in the art." 27 F.3d at 554, 31 USPQ2d at 1132.).

This is similar to the instant situation in which the silicone compositions taught render obvious that claimed but for the preferred self extinguishing additive. As is shown by Matsushita, the combination of FeO/ Fe<sub>2</sub>O<sub>3</sub> and platinum can provide acceptable self extinguishing results and any teaching away that may be found in Matsushita is insufficient to overcome the rejection since applicants have made no discovery beyond what was known in the art and the use of a known, possibly inferior additive over a preferred additive would have been obvious to the skilled artisan.

With regards to claim 11, while Matsushita does not specifically teach these articles, the skilled artisan would have found such articles from the composition of Matsushita to have been obvious since patentee teaches using the composition for molding articles and these are common uses for silicone rubbers.

6. Claims 1 to 3, 8, 9 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Takita et al.

Takita et al. teach silicone rubber compositions that contain a mixture of platinum and cerium oxide, both within the effective amounts of claim 1. Note for instance Table 1, Examples 1 and 2. This peroxide cured siloxane meets the viscosity requirements of claim 8 and the silicone compositions are used to form molded articles, as taught on column 4, lines 52 to 58.

As noted supra, while Takita et al. are silent as to improved arc properties, this method is inherently met by the teachings of Takita et al. since such improvements will inherently be found in the prior art which contains an effective amount of mixture B.

7. Claims 4 to 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takita et al.

While Takita et al. do not exemplify a composition cured with an SiH containing siloxane, they are disclosed on the top of column 5. Note that the viscosity ranges taught on the top of column 3 includes the viscosities of claims 4 to 7 and as such renders obvious the compositions in


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these claims. With regards to claim 10, again note that while these specific articles are not taught by Takita et al., they are common and obvious uses for the silicone composition and articles formed therefrom taught therein. The skilled artisan would have found such articles obvious over that which is known in the art (i.e. the common uses for silicone rubbers) and the teachings of Takita et al.

8. The remaining references are cited as general interest. JP 4023865 and 53006356 (abstracts) teach silicone compositions containing either mixture A or B, but neither is closer to the claims than the prior art cited supra. Wolfer et al. teach silicone compositions containing platinum and a metal oxide which can be cerium oxide, but this also is no closer to the claimed invention than the references cited supra. Bosch et al. teach silicone compositions but fail to teach or suggest the mixtures A, B or C. Nakamura teach silicone rubbers containing a blend of iron oxide but they do not contain the mixtures A, B or C. This reference refers to a Japanese reference which teaches a blend of iron oxides and platinum in a silicone composition. The Examiner is currently trying to obtain a copy of Japan 51 35501 (1976). Finally, Chang et al. teach tracking and erosion resistant silicone compositions. Column 1 teaches platinum compounds as useful tracking and/or erosion resistant additives.

9. Any inquiry concerning this communication should be directed to Margaret G. Moore at telephone number (703) 308-4334.

Any **official** documents (after final rejection) can be faxed to (703) 305-3599. All other **official** faxes should be sent to (703) 305-5408. Please do not send any informal communication or proposed amendments to this number.

  
Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
March 28, 2000